

Attorney's Docket No. PP00693.104 (035784/258145)



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: *Maiorella et al.* Confirmation No.: 9747
Appl. No.: 09/867,948 Group Art Unit: 1653
Filed: May 30, 2001 Examiner: Samuel W. Liu
For: METHOD OF INCREASING PRODUCT EXPRESSION
THROUGH SOLUTE STRESS

January 29, 2003

Commissioner for Patents
Washington, DC 20231

**SUBMISSION OF TERMINAL DISCLAIMER
UNDER 37 C.F.R. § 1.321(c)**

Sir:

Applicants hereby submit the enclosed Terminal Disclaimer Under 37 C.F.R. § 1.321(c) for the above referenced application. Also enclosed is a check in the amount of \$110.00 for a large entity or \$55.00 for a small entity [37 C.F.R. § 1.20(d)] to cover the fee for filing a Terminal Disclaimer. The Examiner is authorized to charge Deposit Account No. 16-0605 for any additional fee that may be required or credit any overpayment.

Respectfully submitted,

Leslie T. Henry
Registration No. 45,714

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Raleigh Office (919) 862-2200
Fax Raleigh Office (919) 862-2260

"Express Mail" mailing label number EL 868645615 US
Date of Deposit January 29, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner For Patents, Washington, DC 20231.

Lynda-Jo Pixley



Attorney's Docket No. PP00693.104 (035784/258145)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Maiorella *et al.*
Appl. No.: 09/867,948
Filed: May 30, 2001
For: METHOD OF INCREASING PRODUCT EXPRESSION
THROUGH SOLUTE STRESS

Confirmation No.: 9747
Group Art Unit: 1653
Examiner: Samuel W. Liu

Commissioner for Patents
Washington, DC 20231

RECEIVED

FEB 04 2003

TECH CENTER 1600/2900

TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321(b)

Sir:

The disclaimant, Chiron Corporation, having a principal place of business at 4560 Horton Street, Emeryville, CA 94608-2916, verifies through its duly authorized representative that it is the owner of all right, title, and interest in the above-identified application, by Assignment filed November 28, 1989, and recorded at Reel 5191, Frame 0228.

The disclaimant hereby disclaims the terminal part of any patent granted on the above-identified application which would extend beyond the expiration date of the full statutory term of United States Patent No. 6,238,891, issued May 29, 2001, entitled *Method of Increasing Product Expression Through Solute Stress*, which patent was assigned to the above-identified disclaimant by an Assignment filed November 28, 1989, and recorded at Reel 5191, Frame 0228.

Disclaimant further agrees that any patent so granted on the above-identified application, which is the subject of this disclaimer, shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,238,891, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Nothing herein shall be construed as a disclaimer of any terminal part of any patent granted on the above-identified application which is prior to the expiration of the full statutory term of U.S. Patent No. 6,238,891 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or

RTA01/2131350v1

01/31/2003 JBALINAN 00000003 09867948

01 FC:1814

110.00 OP

In re: Maiorella *et al.*
Appl. No.: 09/867,948
Filing Date: May 30, 2001
Page 2

terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

I, Lisa E. Alexander, represent that I am an Assistant Secretary of Chiron Corporation and am authorized to execute this disclaimer on behalf of Chiron Corporation. I further declare that the evidentiary documents of ownership have been reviewed, and I certify that to the best of disclaimant's knowledge and belief, title is in the disclaimant seeking to take action.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

CHIRON Corporation

Lisa E. Alexander

By: Lisa E. Alexander

Its: Assistant Secretary

Date: 11/27/03

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 2-14-03

APPL. S.N.: 091867948

TO EXAMINER: S. Liu

ART UNIT: 1653

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 1-29-03

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)